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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/042,386	01/11/2002	Kazuo Fujiura	P 284993 T4KM-01S1334-1	5480
909	7590	08/18/2004	EXAMINER	
PILLSBURY WINTHROP, LLP P.O. BOX 10500 MCLEAN, VA 22102			AGUSTIN, PETER VINCENT	
			ART UNIT	PAPER NUMBER
			2652	
DATE MAILED: 08/18/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/042,386

Applicant(s)

FUJIURA, KAZUO

Examiner

Peter Vincent Agustin

Art Unit

2652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4, 10-12 and 14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 10-12 and 14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election without traverse of Group I, readable on claims 1-18; and species a, figures 1A-1C, readable on claims 1-4, 10-12 & 14, in the reply filed on June 24, 2004 is acknowledged.
2. Claims 5-9, 13 & 15-20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention/species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on June 24, 2004.

### *Priority*

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### *Specification*

4. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors, e.g.,

Page 14, line 18: "eight" should be --ninth--.

Page 17, line 23: "n" should be --not--.

Page 18, lines 11 & 13; page 19, line 9: "leaser" should be --laser--.

Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

5. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 3, 4, 10, 12 & 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Mogi et al. (hereafter Mogi) (JP 08-249802; see English translation).

In regard to claim 1, Mogi discloses an information storage medium (drawing 9) comprising a disc-like shape substrate having a center hole and a peripheral side, said medium comprising: a data area (105) configured to store or to record given information and being formed on the substrate; a clamp area (103) located outside the center hole and inside the data area; and one or more notches or grooves provided on at least one of: a portion of the peripheral side, another portion of the center hole, and still another portion around the clamp area (see drawing 9, element 107).

In regard to claim 3, Mogi discloses that said medium is an optical disc formed of double disc substrates being adhered together with a given adhesive (see drawings 1 & 2 and paragraph 14, line 2).

In regard to claim 4, Mogi discloses that said notch or groove is formed at a corner edge of the peripheral side (as shown in drawing 2).

In regard to claim 10, Mogi discloses that said medium comprises a front surface and a rear surface, and said data area is provided on the front surface (paragraph 19).

In regard to claim 12, Mogi discloses that a label area is provided on the rear surface (suggested by paragraph 4).

In regard to claim 14, Mogi discloses that said one or more notches or grooves is/are configured to indicate a type, or a kind, or a medium side, or contents of the medium (see paragraph 12).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mogi.

For a description of Mogi, see the rejection above. However, in regard to claim 2, Mogi does not disclose that said medium is an optical disc formed of a single disc substrate.

It would have been obvious, however, to one of ordinary skill in the art at the time of invention by the applicant to have used a single-substrate optical disc in lieu of the double-substrate disc of Mogi (see paragraph 14, line 2) because applicant has not disclosed that using a single-substrate disc provides an advantage, is used for a particular purpose, or solves a stated problem, and one of ordinary skill in the art, would have expected applicant's invention to perform equally well with either the double-substrate disc taught by Mogi or the claimed single-substrate disc because both single and double-substrate discs comprise a clamp area and an outer peripheral area where the claimed "notches" or "grooves" might be placed. Furthermore, Mogi

recited the use of a double-substrate disc as an "example" (paragraph 14, line 2), but the teachings of Mogi are obviously applicable to single-substrate discs.

10. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mogi in view of Hida (JP 2000-149403).

For a description of Mogi, see the rejection above. However, in regard to claim 11, Mogi does not disclose that said data area is provided on the rear surface.

Hida discloses an optical storage device having a data area provided on the rear surface (see basic-abstract, novelty). It would have been obvious to one of ordinary skill in the art at the time of invention by the applicant to have provided the data area of Mogi on the rear surface as suggested by Hida, the motivation being to increase the access of duration, thereby raising access (reproduction) capability (see advantage).

### *Conclusion*

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Sekimoto (JP 9320238) discloses an optical disc which type can be determined by the groove provided on the center hole.

Park (US 6,532,210) discloses a disk-type recording medium having a crack hindering element, which includes at least one annular protrusion portion protruded around the center hole.

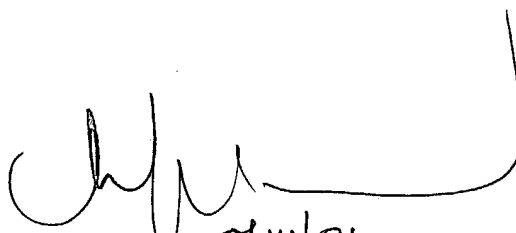
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Vincent Agustin whose telephone number is 703-305-8980. The examiner can normally be reached on Monday-Friday 9:30-5:30 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa Thi Nguyen can be reached on 703-305-9687. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Peter Vincent Agustin  
Art Unit 2652  
07/16/2004



8/18/04  
HOA T. NGUYEN  
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